

REMARKS

At the time of the Office Action dated November 1, 2005, claims 1-11 were pending and rejected in this application. Independent claims 1, 4, and 7 have been amended to clarify that a windows manipulation operation is separate from a focus change operations. Claims 12-14 have been added and recite that interactive user interface elements are positioned separately from a listing of open document windows. Applicant respectfully submits that the present Amendment does not generate any new matter issue.

CLAIMS 1-2 AND 7-8 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY APPLICANT'S ADMITTED PRIOR ART (HEREINAFTER THE ADMITTED PRIOR ART)

On pages 2 and 3 of the Office Action, the Examiner asserted that the Admitted Prior Art discloses a method and machine readable storage corresponding to that claimed. This rejection is respectfully traversed.

On page 2 of the Office Action, the Examiner asserted that the claimed pre-defined window manipulation operation upon an inactive open document window is identically disclosed by the "the change of focus from the active window to the selected inactive window." Although Applicant respectfully disagrees with the Examiner construing the phrase "window manipulation operation" so as to encompass a "change of focus," Applicant notes that independent claims 1 and 7 have been amended to clarify the distinction between the claimed invention and the Admitted Prior Art. Specifically, independent claims 1 and 7 have been amended to recite that

the pre-defined window manipulation operation is separate from a focus change operation. Since the claims exclude a focus change, the Admitted Prior Art fails to identically disclose the claimed invention.

Therefore, for the reasons stated above, the Admitted Prior Art fails to identically disclose the claimed window manipulation operation, as recited within independent claims 1 and 7, within the meaning of 35 U.S.C. § 102. Thus, Applicant respectfully solicits withdrawal of the imposed rejection of claims 1-2 and 7-8 under 35 U.S.C. § 102 for anticipation based upon the Admitted Prior Art.

CLAIMS 3-6 AND 9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON THE ADMITTED PRIOR ART IN VIEW OF BEAUDET ET AL., U.S. PATENT NO. 5,491,795 (HEREINAFTER BEAUDET)

On pages 3-6 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the Admitted Prior Art in view of Beaudet to arrive at the claimed invention. This rejection is respectfully traversed.

Motivation lacking factual support

With regard to the asserted motivation to combine the Admitted Prior Art in view of Beaudet, the Examiner stated:

One would be motivated to make such a combination due to the fact that the pull-down menu presents a list of windows to the user, as does the window control management system of Beaudet. Therefore, in order to save space on screen and allow for an easily accessible window menu, one would be motivated to combine the admitted prior art and Beaudet.

In the Response filed July 5, 2005, Applicant argued that the Examiner has not asserted a proper motivation to combine. Specifically, the Examiner has not factually established that the motivation to modify the applied prior art comes is derived from the applied prior art.

In response to Applicant's argument the Examiner stated the following in the paragraph spanning pages 8 and 9 of the Office Action:

In response to Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 12 of the remarks), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As readily apparent, the Examiner has copied this "response" to Applicant's arguments from M.P.E.P. § 2145(X)(A). The Examiner, however, has not accompanied this "canned response" with any analysis. Moreover, Applicant directs the Examiner to the last line of M.P.E.P. § 2145(X)(A), which states "[s]ee MPEP § 2143.01 for a discussion of proper motivation to combine references."

The Federal Circuit decision of *In re Lee*,¹ which is briefly discussed in M.P.E.P. § 2144.01, provides an illuminating discussion on the burden placed on an Examiner to establish objective factual finds of record for the requisite motivation to combine. This case was an appeal from a decision of the Board of Patent Appeals (hereinafter the Board) in which Lee argued that the Examiner failed to provide a source of a teaching, suggestion, or motivation to

¹ 277 F.3d 1338 (Fed. Cir. 2002).

combine the applied prior art to arrive at the claimed invention. The Board responded to Lee's argument by ruling "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

The Federal Circuit overturned the Board's decision "for failure to meet the adjudicative standards for review under the Administrative Procedure Act." The Court stated:

Judicial review of a Board decision denying an application for patent is thus founded on the obligation of the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions. (emphasis added)

The Court then focused on the failure by the Patent and Trademark Office (PTO) to provide a factual basis for the motivation to combine the applied prior art. For example, the Court stated:

"The factual inquiry whether to combine references must be thorough and searching." ... It must be based on objective evidence of record. This precedent has been reinforced in myriad of decisions, and cannot be dispensed with.

On the basis of several previous decisions that call for specificity and factual support in the PTO's rejections, the Court attacked the Examiner's conclusory statements regarding the obviousness of the proposed combination as being factually unsupported. With regard to the Board decision, the Court stated:

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The Court also stated that the PTO is "not free to refuse to follow circuit precedent" and "cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims."

The Examiner's asserted motivation to combine, which is "to save space on screen and allow for an easily accessible window menu," and lack of factual support thereof comports very closely to the analysis disapproved by the Federal Circuit in In re Lee. As such, the Examiner's failure to provide factual support for a teaching, suggestion, or motivation to combine the applied prior art constitutes legal error.

Combination fails to teach claimed invention

Notwithstanding the Examiner failing to provide factual support for the requisite motivation to modify the Admitted Prior Art in view of Beaudet, even if, one having ordinary skill in the art were motivated to modify the Admitted Prior Art in view of Beaudet the claimed invention would not result.

As discussed in M.P.E.P. § 2141.02(VI), "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis added).² In considering Beaudet as a whole, Beaudet considers his invention to be "a single control window container on a computer display containing representations of product windows or related file windows" (column 3, lines 18-20). Beaudet further states that "[t]he control

² W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

window container enables a user to control each individual product window by using or manipulating the representations and by integrating together the individual windows" (column 3, lines 22-25). The control window 10b includes miniature windows 51, 55 that correspond to product windows 31, 35 that are separate from the control window 10b (column 4, lines 59-65, and Fig. 3).

Comparing the teachings of the Admitted Prior Art (i.e., Fig. 1) and Fig. 1 of Beaudet, it is readily apparent that the only major difference between these teachings is the inclusion of the control window 10 in Fig. 1 of Beaudet. Therefore, even if one having ordinary skill in the art were motivated to modify the Admitted Prior Art, the obvious modification would be to include the entire control window 10 of Beaudet within the Fig. 1 of the Admitted Prior Art. Thus, even if the applied prior art were combined, the claimed invention would not result.

The Examiner asserts that it would have been obvious to "modify the pre-defined window manipulation through pull-down menus of the admitted prior art with the interactive window list control system of Beaudet." The product windows 31, 35 of Beaudet, however, already include pull-down menus. Therefore, if the Examiner's proposed modification was obvious to one having ordinary skill in the art, then Beaudet would have made the modification. The fact that Beaudet did not recognize this so-called "obviousness modification" is evidence that the claimed invention was not obvious to one having ordinary skill in the art.

It should, therefore, be apparent that one having ordinary skill in the art would not have arrived at the claimed invention based upon the Admitted Prior Art in view of Beaudet. Thus, Applicant respectfully solicits withdrawal of the imposed rejection of claims 3-6 and 9 for obviousness based upon the Admitted Prior Art in view of Beaudet.

**CLAIMS 10 AND 11 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON THE ADMITTED PRIOR ART**

On pages 6 and 7 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the Admitted Prior Art to arrive at the claimed invention. This rejection is respectfully traversed.

In the Response filed July 5, 2005, Applicant argued the following:

Independent claim 10 has been amended to clarify that the corresponding interactive user interface elements are positioned separately from the listing of selected operating system services. *Assuming arguendo* that the window list 140 inherently discloses a list of selected operating system services and each element of the list is an interactive user interface element, the Admitted Prior Art still fails to teach or suggest the claimed invention, since the interactive user interface elements are not positioned separately from the listing of selected operating system services, as recited in amended claim 10. Instead, based upon the Examiner's construction of the terms "corresponding interactive user interface elements" and "listing of selected operating system services," these features are one and the same.

In the paragraph spanning pages 6 and 7 of the Office Action, the Examiner asserted the following:

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to position a corresponding interactive interface element separately from a related operating system service. Applicant has not disclosed that position a listed operating system service and a corresponding interactive user interface elements provides an advantage, is used for a particular purpose, or solves a stated problem.

Applicant is unaware of any requirement that a particular feature "provides an advantage, is used for a particular purpose, or solves a stated problem." As stated in the second paragraph of 35 U.S.C. § 112, the claims are required to "particularly [point] out and distinctly [claim] the subject matter which the applicant regards as his invention." Wholly absent from 35 U.S.C. § 112 is a requirement that the claims recite particular advantage, purpose, or why the claims solve a stated problem.

Notwithstanding the Examiner failing to establish why this requirement is germane to a rejection under 35 U.S.C. § 103 for obviousness, it is readily apparent to one having ordinary skill in the art that "interactive user interface elements" (e.g., buttons) have much greater functionality than just a listing of operating system services. For example, a user may select more than one interactive user interface element and, thus, be able to manipulate several services. Moreover, more than one interactive user interface element may be associated with a particular operating system service.

The Examiner further asserted the following:

One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Applicant's admitted prior art because both perform the listed operating system service when selected.

Again, the Examiner appears to be making arguments that are not germane to a rejection under 35 U.S.C. § 103 for obviousness. Whether or not the claimed invention and the Admitted Prior Art "perform equally well" is irrelevant to determining whether or not the claimed invention is obviousness in view of the Admitted Prior Art. An obviousness rejection is based upon what the

applied prior art teaches vis-à-vis the claimed invention, not the performance of the applied prior art relative to the performance of the claimed invention.

The Examiner finally stated the following with regard to motivation to modify the Admitted Prior Art so as to arrive at the claimed invention recited in claim 10:

Furthermore, the placing of user-manipulable interface objects such as checkboxes or radio buttons next to a listed item or service, and the subsequent manipulation and selection of that listed item or service are notoriously well-known in the art, and would have been similar obvious to include in the pull down menu of Applicant's admitted prior art.

Applicant does not disagree that the use of checkboxes or radio buttons "are notoriously well-known in the art." The fact that a particular feature may be "notoriously well-known" is not relevant to whether or not the inclusion of that particular feature in a particular invention is obvious. If a feature being well-known was all that was required to establish that a modification to include that feature would have been obvious, then most inventions would never be patented.

As recognized by the Federal Circuit, "virtually all [inventions] are combinations of old elements."³ Thus, every element of a claimed invention may often be found in the prior art. However, mere identification in the prior art of each individual element claimed is insufficient to establish the requisite realistic motivation to support the legal conclusion of obviousness under 35 U.S.C. § 103.⁴ Rather, to establish obviousness, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by Applicant.⁵

³ In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)).

⁴ Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

⁵ See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Since the Examiner is relying on the "notoriously well-known" nature of the missing feature for the motivation to modify the Admitted Prior Art without factually establishing some motivation, suggestion, or teaching to make the modification, Applicant respectfully submit that the Examiner has failed to establish a proper motivation to modify the Admitted Prior Art. Therefore, Applicant respectfully solicits withdrawal of the imposed rejection of claims 10 and 11 under 35 U.S.C. §103 for obviousness based upon the Admitted Prior Art.

Newly added dependent claims 12-14 recite that the interactive user interface elements (e.g., checkboxes/radio buttons) are positioned separately from the listing of open document windows. Thus, for the reasons stated above, Applicant respectfully submits that these claims further distinguish the claimed invention over the Admitted Prior Art.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or

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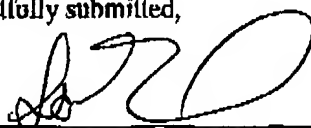
Attorney Docket No.: RSW920010228US1 (7161-29U)

omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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